

Appl. No. 10/604,495
Amd. Dated July 13, 2005
Office Action Dated April 13, 2005

REMARKS/ARGUMENTS

Claims 1-56 remain in this application. Claims 2-16, 22, 36-47, 50, 51 and 54 have been withdrawn as non-elected claims. Claim 1 has been amended herein. No New matter has been added by way of these amendments. Support for the amendment to Claim 1 is found, for example, at paragraph [0062] of the Specification.

Election/Restriction

Applicant hereby confirms the provisional election of Species I, Claims 20-21, 23-35, 48-49, 52-53 and 55-56 with traverse. Applicant has withdrawn Claims 2-16, 22, 36-47, 50-51 and 54 as being drawn to a non-elected invention.

Information Disclosure Statement

On July 12, 2005, Applicant submitted an Information Disclosure Statement containing US Patent No. 5,195,588. A copy of the IDS is attached hereto. Applicant requests consideration of this reference.

Claim Rejections – 35 USC § 102

Claims 1, 17, 18-21, 23-28, 34, 48-49, 52-53 and 55-56 stand rejected under 35 U.S.C. § 102 as being unpatentable over Urbanosky (3924463), MacDougall (5692565) and/or Bond (6772839). This rejection is respectfully traversed.

Each of the pending claims relate to a debris blocker or techniques for blocking debris in a perforation. As shown in Fig. 9 of the present application, bit (19a) is positioned in the perforation to block debris (186) from entering the tool with the formation fluid as it passes through the perforation and into the downhole tool. No such techniques are provided by the art of record.

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Urbanosky relates to a probe positionable against a wellbore for drawing fluid into the formation. As shown in Figs 1 and 2 of Urbanosky, a probe or fluid admitting means (10) with a sealing member (39) is positioned against the wellbore wall, and fluid is sucked into the downhole tool through an inlet in the probe. There is no disclosure in Urbanosky of a perforation or a debris blocker positionable in the perforation. MacDougall, therefore, fails to anticipate Claim 1 (or any of the claims that depend therefrom).

MacDougall relates to an apparatus for perforating, testing and resealing a casing. With MacDougall, a bit (19) is extended into the sidewall of a wellbore via a flexible shaft (18) to create a perforation. *See, MacDougall, Fig. 1.* There is no disclosure of a debris blocker or bit positionable in the perforation via the arm and releasable therein as recited in amended Claim 1. MacDougall, therefore, fails to anticipate Claim 1 (or any of the claims that depend therefrom).

Bond relates to a perforating apparatus including a piercing member (90) that extends radially into the sidewall of a wellbore. *See, Bond, Col. 8, Lines 9-12.* Bond teaches away from any type of debris blocking by providing the piercing member (90) with a helical groove (100) to assist fluid flow into the tool (*See, Bond, Fig. 3*), and therefore the opportunity for debris to pass into the tool with the fluid. Bond, therefore, fails to anticipate Claim 23 or Claim 52 (or any of the claims that depend therefrom).

Rejection(s) under 35 U.S.C § 103

Claims 29-33 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bond in view of Urbanosky, Taggart (3430711) or Brieger (3934468). This rejection is respectfully traversed. The cited art fails to provide at least one limitation of the present claims.

Claim 23 recites a method for reducing debris involving positioning the bit in the perforation to block debris as formation fluid flows from the perforation into the downhole tool

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whereby contamination is reduced. As discussed above with respect to the 102 rejection, Bond relates to a perforating apparatus including a piercing member (90) that extends radially into the sidewall of a wellbore. *See, Bond, Col. 8, Lines 9-12.* Bond teaches away from any type of debris blocking by providing the piercing member (90) with a helical groove (100) to assist fluid flow into the tool (*See, Bond, Fig. 3*), and therefore the opportunity for debris to pass into the tool with the fluid. Thus, Bond fails to support a finding of obviousness of any of the pending Claims.

Urbanosky, Taggart and Brieger fail to provide the deficiencies of Bond. As discussed above, Urbanosky fails to even contemplate perforations or positioning a bit in a perforation to block debris. Taggart also fails to even contemplate positioning a bit in a perforation to block debris. Instead, Taggart teaches a screen or filter plug for a perforation. *See Taggart, Col. 1, lines 15-17.* Brieger teaches a probe (63) extendable into the earth, but also fails to even contemplate any perforations, or positioning a bit in a perforation to block debris. Thus, the cited references alone or in combination fail to teach or even suggest at least one limitation of the claims and, therefore, fail to support a finding of obviousness of the claims.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below.

This paper is submitted in response to the Office Action dated March 18, 2004 for which the three-month date for response is July 13, 2005. Please apply any charges not covered, or any credits, to Deposit Account 19-0610 (Reference Number 20.2771).

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Respectfully submitted,

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ATTACHMENT